

REMARKS

Status of the Claims

Upon entry of the present amendment, claims 31-52 and 56-63 will remain pending in the above-identified application. Claims 56-63 are withdrawn from further consideration. Claims 33, 34 and 36 have been amended to correct formalities. Claims 53-55 have been cancelled without prejudice or disclaimer of the subject matter contained therein.

The present amendments to the claims do not introduce new matter into the application as originally filed. Further, the instant amendment does not raise substantial new issues for the Examiner's consideration nor require further search on the Examiner's part. At the same time, the instant amendments place the pending claims in condition for allowance and into a more proper format for issuance in a United States patent, by overcoming all outstanding rejections and objections of record.

As such entry of the instant amendment and favorable action on the merits is earnestly solicited.

Request for Continuing Examination and Request for 3 Month Suspension of Action

Applicants have filed a Request for Continuing Examination with **a request for suspension of action** under 37 C.F.R. 1.103(c) for a period of **three (3) months** on the above-identified application. Applicants respectfully request that **the request for 3 month suspension of action** be granted.

Claim Objections

The Examiner has objected to claims 33, 34, 44-46 and 53-55 because of several informalities. The objections are respectfully traversed.

The phrase “the concentration of the solution” in claims 33 and 34 are amended to read “the concentration of the starch derivative of the solution” (emphasis added), respectively, per the Examiner’s indication. Further, claims 53-55 are cancelled in the present reply so as to remove the redundancy as pointed out in the Office Action.

Thus, in view of the present amendments to the claims, the objections have been overcome. Thus, reconsideration and withdrawal of the objections are respectfully requested based on the new claims.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 31, 36 and 49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is respectfully traversed.

Claim 31

It is alleged at page 4 of the Office Action that although claim 31 recites that the solution of starch derivative and a mixture of a solvent and water are brought into contact with a non-solvent, the fate of the non-solvent thereafter is unclear.

However, the present invention is directed to a method (not a product). Even if the fate of the non-solvent is unclear, the claimed method (*i.e.*, a method of manufacturing a starch-based pigment or filler) is sufficiently clear to one skilled in the art.

Thus, reconsideration and withdrawal of the rejection are respectfully requested.

Claim 36

Claim 36 has been amended to read “... *the starch derivative has a glass transition point of at least 100°C, or is not broken down at the temperature of 100°C*” (emphasis added). Thus, in view of the present amendment to claim 36, the objection has been overcome.

Claim 49

Claim 49 should be clear as read. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 31-40, 42-48 and 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bengs et al. US ‘459 (US 6,562,459) in view of Tanaka US ‘449 (US 6,617,449).

Claim 41 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bengs et al. US ‘459 in view of Tanaka US ‘449 and Rudolph et al. US ‘392 (US 4,011,392).

Claim 49 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bengs et al. US ‘459 in view of Tanaka US ‘449 and Portnoy et al. US ‘186 (US 4,716,186).

The rejections are respectfully traversed.

Nonobviousness over the Combination of the Cited References

The remarks set forth in the prior response of March 1, 2010 are incorporated herein by reference, and the Examiner is respectfully requested to consider the same at present as they are believed to remain pertinent to the outstanding rejections, vis-à-vis, the pending claims.

In short, the cited references (*i.e.*, Bengs et al. US '459, Tanaka US '449, Rudolph et al. US '392 and Portnoy et al. US '186) fail to disclose or suggest the claimed features. Therefore, there is no rationale and/or reasonable expectation of success based on the combination of the cited references, by which one skilled in the art could arrive at the present invention as claimed. Thus, it is submitted that the present invention is not obvious over the combination of the cited references.

Based on the foregoing considerations, Applicants respectfully request that the Examiner withdraw the objections and the rejections.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims is allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Toyohiko Konno, Reg. No. L0053 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By 

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